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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,981	02/28/2005	Kyoko Ishimoto	2005-0264A	5014

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EXAMINER	
DEES, NIKKI H	
ART UNIT	PAPER NUMBER
1794	
MAIL DATE	DELIVERY MODE
12/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/525,981	ISHIMOTO ET AL.	
	Examiner	Art Unit	
	Nikki H. Dees	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendment filed September 9, 2008, has been entered. Claims 1-6 remain pending in the application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (3,749,588).

4. Hunter teaches a process for producing acidic gel foods comprising soy protein at about 0.3 to 10 wt% protein. The invention further comprises an anionic polymer (pectin) in an amount ranging from 12 to 20 wt% (col. 2 lines 14-17). The gel food may be acidified with citric acid or any acceptable acid to obtain the desired pH (col. 3 lines 47-50). Hunter speaks to the problems with the prior art and the precipitation of proteins in jelly products due to their acidity. His invention provides for a clear appearance while providing a protein supplemented food product (col. 1 lines 29-50).

5. Hunter speaks to the process by which the acid-soluble soy-protein is produced, stating that the process yields 67% protein that is soluble at pH 3 and two-thirds of the

protein produced by the process may be added to the jelly (col. 3 lines 17-23). The acid-soluble protein added to the jelly would thus be expected to be entirely soluble at pH 3 as the insoluble portion would not be added.

6. Regarding the gel being formed by gelation of the acid-souble soybean protein, as the final composition of Hunter is a rigid gel (col. 2 lines 15-17), the acid-soluble soybean protein present in the final gelled composition, and therefore the soybean protein is considered to be gelled by gelation.

7. Hunter does not teach the amount of acid to be added to the solution in terms of concentration. It is only reported to adjust the pH. However, given that the acid-gel food product of Hunter is substantially similar to that as claimed by Applicants, absent any clear and convincing arguments and/or evidence to the contrary it would be expected that the amount of acid used by Hunter is the same as that claimed by Applicants.

8. Regarding the heating of the solution, Hunter states that the solution without the protein is heat to its boiling point (100°C) then cooled before the addition of the protein so that the protein is not denatured.

9. Hunter does not state to what temperature the solution is cooled. Hunter does state that the combined mixture is allowed to cool, indicating that the mixture is still reasonably warm when the protein is added (col. 4 lines 29-31). It would be expected that the solution would form a partial gel at temperatures greater than 60°C, at which point the protein would be added. The temperature could be maintained for 10 minutes or more in order to affect the desired final gelled texture. The determination of the

heating time would be within the abilities of the artisan to determine. Undue experimentation would not have been required, and there would have been a reasonable expectation that the resultant jelly food would maintain its favorable textural properties.

Response to Arguments

10. Applicant's arguments, see Remarks, filed September 9, 2008, have been fully considered but they are not persuasive.

11. Applicant argues (Remarks, p. 4) that the soybean protein of the instant invention is distinguished from the soybean protein of the prior art as the instant protein is soluble "at pH 3.0 to 4.5"

12. As the soluble portion of the protein of Hunter is soluble at pH 3, it is considered to meet the limitation of "having a solubility of 80% or more at pH 3.0 to 4.5". The claim does not require that the protein be soluble over the entire range of pH 3.0 to 4.5. Further, the protein of Hunter is considered to be greater than 80% soluble as the insoluble fraction has been removed, leaving only the soluble fraction for addition to the gel food.

13. Applicant argues (Remarks, p. 5) that one of ordinary skill would not maintain the temperature at greater than 60°C for more than 10 minutes.

14. The temperature could be maintained for 10 minutes or more in order to affect the desired final gelled texture. The determination of the heating time would be within the abilities of the artisan to determine.

15. Applicant also notes that "pectin does not form a gel only by heating" (Remarks, p. 5).

16. In response, it is noted that there is no limitation in the claims concerning the treatment of the gel after it has been heated. As the claimed process comprises heating, processes incorporating heating, followed by other treatments, are considered to read upon the instant claims.

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7 of copending Application No. 10/585,661. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a method for producing an acid-soluble soybean protein-containing gel and comprise mixing the protein with water and a polar solvent (alcohol).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/
Primary Examiner
Art Unit 1794

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